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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,251	01/31/2002	Bruce A. Jacobs	ABN0006-US	6565

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EXAMINER

POLTORAK, PIOTR

ART UNIT PAPER NUMBER

2134

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/059,251	Applicant(s) JACOBS ET AL.	
	Examiner Peter Poltorak	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/25/2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-33 have been examined.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on a U.S. Provisional Application No. 60/265351 filed on February 1, 2001.

#### ***Claim Objections***

3. Claims 1, 4 and 33 use term "a third party". However, the claims do not explicitly require interaction between more than two parties and one of these two parties could be treated as "the third party", which the examiner believes it not what applicant envisions. The examiner suggests using the more precise language as it is disclosed in claims 14 and 23 for example.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Art Unit: 2134

5. The term "a valuation" ("wherein the at least one predetermined rule comprises a valuation of the software package") in claim 11 is not understood. In light of the specification f the phrase is treated as "a term" or "terms of use".
6. Claims 1, 23 and 25 use term "an electronic wrapper". The term is not clear. In the specification applicant recites: "Information can be captured using well-known electronic wrapping techniques or via monitoring agents, like that disclosed in U.S. Pat. No. 5,675,510". However, the clarification of the term was not found in the cited patent.

For purposes of further examination the phrase is treated as best understood.

7. Claims 2-13, 24 and 26-32 are rejected by virtue of their dependence.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by *Wyman* (U.S. Patent No. 5745879).
9. As per claim 1 *Wyman* teaches that "the license server 10, using the license management program 11, maintains a license data file 23 comprising a number of license document or licenses (product use authorization), and also maintains a log

Art Unit: 2134

24 which is a record of the usage activity of all of the user CPUs 16 of each of the licensed programs" (col. 9 lines 23-28) which reads on: "(a) associating at least one predetermined rule with a software package".

10. Furthermore *Wyman* teaches that "each licensed program upon start-up makes a call to a license server to check on whether usage is permitted, and the license server checks a database of the licenses, called product use authorizations, that it administers. If the particular use requested is permitted, a grant is returned to the requesting user node" (*Abstract*), which reads on "(b) receiving an indication of an attempt by a user to access the software package" and on "(c) comparing the indication to at least one predetermined rule".

11. *Wyman* discloses that "at least step (c) is performed by a trusted third party" in col. 9 lines 29-31: "the License Server has no authority to originate a license, but instead must receive a license from a license issuer 25" (col. 9 lines 29-31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-6, 8-18, 20-26 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Coley et al.* (U.S. Patent No. 5790664) in view of *Horstmann* (U.S. Patent No. 6009401).

13. As per claim 1 *Coley et al.* teach that a client module that utilizes the public network as a means to transparently send license inquiry request messages to, and receive license inquiry response messages from, a license server maintained by a software provider. The license server has a database on which license information, or records, are stored. The license server also can record information contained in license inquiry request messages, and thereby audit use of client applications. The license record can identify a license in accordance with a hardware address, or hardware identifier of the computer, such as an IP address. Furthermore *Coley et al.* teach that the client module automatically initiates a process to determine whether the software application is validly licensed. This can happen each time the client application is brought up (*Coley et al.*, col. 8 lines 1-5).
14. This reads on: “(a) associating at least one predetermined rule with a software package, (b) receiving an indication of an attempt by a user to access the software package, and “(c) comparing the indication to at least one predetermined rule, wherein at least step (c) is performed by a trusted third party”.
15. As per claims 2-6, 8-14, 16-17, 20, 21-23, 25-26, 28-30 and 33 *Coley et al.* teach monitoring access via at least one of electronic wrapping and an agent (*Coley et al.*, col. 4 lines 4-7 and 23-26), the user and the trusted third party communicating with each other via the Internet (*Coley et al.*, col. 8 lines 60-67 and 14 lines 7-12), that at least one predetermined rule corresponds to a term of a license for the software package ( *Coley et al.*, col. 14 lines 35-41 and 15 lines 1-11), permitting use of the software package by the user if it is determined by the trusted third party that the

Art Unit: 2134

user has a valid software license (*Coley et al.*, col. 4 lines 39-47), collecting software package usage data, offering software package usage plan to the user in the event the user does not have a valid software license (*Coley et al.*, col. 5 lines 23-29).

16. *Coley et al.* do not teach that a third trusted party is involved in the software license compliance process and do not teach that the third party is involved in payments.

17. *Horstmann* teach a third trusted party (*Clearinghouse*) that is trusted by both software vendor and software user and that is involved in the software license compliance process (*Horstmann*, Fig. 1 col. 4 lines 12-38), and that is involved in the payment (*Horstmann*, col. 1 lines 45-46).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to involve a third trusted party in the software license compliance process and payment as taught by *Horstmann*. One of ordinary skill in the art would have been motivated to perform such a modification in order to alleviate a vendor from additional responsibility of protecting the product and to allow the vendor concentrating on software distribution.

18. As per claims 15 and 24 *Coley et al.* and *Horstmann* do not explicitly teach that the third party is at least one of a bank, an accounting firm and a university. However, *Horstmann et al.* suggests that the third party responsibilities can be performed by any entity. Employing a bank or accounting firm would have been an obvious choice to one of ordinary skill in the art at the time given the benefit that banks handle financial transactions and accounting firms specialize in maintaining financial and statistical data.

Art Unit: 2134

19. As per claim 31 *Coley et al.* and *Horstmann* do not explicitly teach offering a statement of usage to at least the software package user.
20. Official Notice is taken that it is old and well-known practice to provide a user with financial and utility statements. One of ordinary skill in the art at the time of applicant's invention would have been motivated offer a statement of usage to at least the software package user in order to provide record information for the user at least for reconciliation purposes.
21. Claims 7, 19 and 27 are rejected under 35 U.S.C. 103(a) as being anticipated by (*U.S. Patent No.*) unpatentable over *Coley et al.* (*U.S. Patent No. 5790664*) in view of *Horstmann* (*U.S. Patent No. 6009401*) and in further view of *Wyman* (*U.S. Patent No. 5745879*).
22. As per claim 7, 19 and 27 *Coley et al.* and *Horstmann* teach a method of controlling software usage as discussed above.
23. *Coley et al.* and *Horstmann* do not explicitly teach that the vendor and the user negotiate terms of the software license.  
  
*Wyman* teaches the user negotiating terms of the software license with a vendor (*Wyman, col. 2 lines 66-col. 3 lines 27*).
24. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to a user to negotiate terms of the software license with a vendor as taught by *Wyman*. One of ordinary skill in the art would have been motivated to perform such a modification in order to increase the possibility of the transaction.



Art Unit: 2134


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Signature  
  
10/13/05  
Date

  
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